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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,892	12/03/2003	Colin J. Price-Smith	68.0294DIV	4173

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EXAMINER

WALKER, ZAKIYA NICOLE

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,892

Applicant(s)

PRICE-SMITH ET AL.

Examiner

Zakiya N. Walker

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-21 is/are allowed.
- 6) ☒ Claim(s) 1- 3, 6-9, 14, 22, 23, 25, 26, 29, 31, and 34 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 10-13, 15-17, 27, 28, 30, 32 and 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because the last 4 lines should be deleted and replaced with proper content and language. Correction is required. See MPEP § 608.01(b).
2. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology

often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The disclosure is objected to because of the following informalities: page 1, the first paragraph should be updated to include the patent number --6,719,064--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Heath et al.

Heath et al. discloses a well treatment that includes a method of completing a well comprising: expanding an expandable sand screen in a well; and gravel packing a rat hole of the well. The reference teaches providing the material about a screen that may be of any type, including expandable.

7. Claims 2, 3, 6-9, 14, 22, 23, 25, 26, 29, 31, and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Nguyen et al.

Nguyen et al. comprises a method of completing a well comprising, expanding a pair of spaced expandable sand screens 35 in a well, the expandable sand screens connected to one another by an unexpanded tubing section (joint connection 42), and gravel packing the portion of the well around the unexpanded tubing section (gravel throughout annulus 23). With respect to claim 3, further comprising: inserting an inner completion 40 into the expandable sand screens and the unexpanded tubing section; and isolating the expandable sand screens by sealing between the inner completion and the unexpanded tubing section (seal may be placed about 42). With respect to claims 6-9, the method teaches a method of completing a well comprising: gravel packing around an expandable tubing section; wherein gravel packing comprises gravel packing above the expandable tubing section; wherein gravel packing comprises gravel packing below the expandable tubing section; wherein gravel packing comprises gravel packing between the expandable tubing section and another expandable tubing section. With respect to claim 14, the method teaches: a method of completing a well, comprising: expanding an expandable sand screen below an unexpanded tubing section; and gravel packing a region above the expandable sand screen and around the unexpanded tubing section. With respect to claims 22, 23, 25, 26, 29, 31, and 34, the reference teaches: A well completion system, comprising: at least two expandable tubing sections; an unexpanded tubing section between the at least two expandable tubing sections; and a gravel pack provided about the unexpanded tubing section; further comprising a seal on an exterior of the unexpanded tubing section; wherein the at least two expandable tubing sections and the unexpanded tubing section form an

outer conduit; further comprising an inner completion at least a portion of which is positioned in the outer conduit, the inner completion comprising a completion tubing and a seal; wherein the seal creates a seal between the completion tubing and the unexpanded tubing section to substantially isolate the expandable tubing sections from each other; further comprising an inner tubing positioned within the at least two expandable tubing sections and the unexpanded tubing section, and a seal between the tubing and the unexpanded tubing section; wherein the seal is selected from a packer and a seal assembly; and wherein the expandable tubing sections comprise expandable sand screens.

8. Claims 6-8 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Haut et al.

Haut et al. discloses an expandable screen and method that includes, with respect to claims 6-8, a method of completing a well comprising: gravel packing 42 around an expandable tubing section 10; wherein gravel packing comprises gravel packing above the expandable tubing section; and wherein gravel packing comprises gravel packing below the expandable tubing section. With respect to claim 14, the method teaches: a method of completing a well, comprising: expanding an expandable sand screen 10 below an unexpanded tubing section (tubing between 10 and 50); and gravel packing a region above the expandable sand screen and around the unexpanded tubing section.

Double Patenting

9. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or

discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

10. Claim 23 and 24 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 11 and 2 of prior U.S. Patent No. 6,719,064. This is a double patenting rejection.

Allowable Subject Matter

11. Claims 18-21 are allowed.

12. Claims 4, 5, 10-13, 15-17, 27, 28, 30, 32, and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion


13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Donnelly et al. and WO'724 teach systems that include gravel packing around expandable tubing.

Art Unit: 3672

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zakiya N. Walker whose telephone number is (703) 305-0302. The examiner can normally be reached on Tuesday-Friday, 6:30 AM-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Zakiya N. Walker
Primary Examiner
Art Unit 3672

ZW
June 16, 2004